

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1, 4-8, and 11-22 are presently pending. By this Amendment, claims 1, 8, and 18 have been amended to further define the friction modifying compound. Support for these amendments can be found in the originally filed specification, for example at page 9, lines 17-27 and page 21, lines 10-11. No new matter has been added.

Applicants thank the Examiner for withdrawing the rejections of record, except for those discussed below.

### **REJECTIONS UNDER 35 USC §103**

1. U.S. Patent Application No, 2002/0119895 in view of U.S. Patent No.

4,755,311 and STN Structure

The Examiner has rejected claims 1, 4-5, 7-8, and 11-20 under 35 USC §103(a) as being unpatentable over U.S. Patent Application No, 2002/0119895 to Cook et al. (hereinafter "Cook") in view of U.S. Patent No. 4,755,311 to Burjes et al. (hereinafter "Burjes") and STN Structure . See page 2 of the Final Office Action. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the Examiner has failed to show that the combination of references teaches or suggests all of the claimed elements.

Cook discloses a lubricating composition comprising a molybdenum composition which improves the antiwear properties of the lubricant. See para. [0001]. However, Cook fails to teach or suggest a long chain alkyl phosphonate friction modifying compound, as recited in the presently amended claims. In fact, Cook does not teach or suggest any particular friction modifying compound, much less one such as that

presently claimed. Moreover, none of the Examples in *Cook* utilize any friction modifying compound. Therefore, *Cook* does not teach or suggest the presently claimed friction modifying compound.

*Burjes* does not overcome the deficiencies of *Cook*. In particular, the Examiner relied on *Burjes*, a reference disclosed in *Cook*, for teaching specific types of monothiophosphoric acids. However, *Burjes* fails to teach or suggest the presently claimed friction modifying compound. Rather, *Burjes* only discloses friction modifiers generally as one ingredient among a long list of optional additives, without teaching any friction modifier in particular. See col. 55, line 25.

Accordingly, the combination of *Cook*, *Burjes*, and *STN Structure* fails to teach or suggest all of the claimed elements. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection.

2. U.S. Patent No. 5,942,470 in view of *Cook* and *STN Structure*

The Examiner has rejected claim 6 under 35 USC §103(a) as being unpatentable over *Cook* in view of *Burjes* and *STN Structure* as applied to claims 1, 4-5, 7-8, and 11-20 above, and further in view of U.S. Patent No. 5,942,470 to Norman et al. (hereinafter "Norman.") See page 2 of the Final Office Action. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the Examiner has failed to show that the combination of references teaches or suggests all of the claimed elements.

Applicants respectfully submit that claim 6 depends from independent claim 1 and is patentable for the same reasons as claim 1. In particular, *Cook* in view of *Burjes*

and STN Structure do not teach or suggest claims 1, 4-5, 7-8, and 11-20 for at least the reasons discussed above.

Moreover, *Norman* does not overcome the deficiencies of *Cook* in view of *Burjes* and STN Structure. In particular, *Norman* does not teach or suggest the presently claimed friction modifying compound, which is a long chain alkyl phosphonate. Instead, *Norman* teaches that component (iii) is an oil-soluble succinimide compound (see Abstract), which can be a single compound or a mixture of two or more compounds of the formula shown in col. 11, lines 50-67. Furthermore, none of the Examples in *Norman* utilize any friction modifying compound other than an oil-soluble succinimide compound.

Accordingly, the combination of *Cook*, *Burjes*, and STN Structure in view of *Norman* fails to teach or suggest all of the claimed elements. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection.

### 3. *Norman* in view of *Cook* and STN Structure

The Examiner has rejected claims 1, 4-5, 7-8, and 11-20 under 35 USC §103(a) as being unpatentable over *Norman* in view of *Cook* and STN Structure. See page 3 of the Final Office Action. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

For at least the reasons discussed above, *Norman* does not teach or suggest the presently claimed friction modifying compound, which is a long chain alkyl phosphonate. Instead, *Norman* teaches an oil-soluble succinimide compound. Moreover, for at least the reasons discussed above, *Cook* and STN Structure do not overcome the

deficiencies of *Norman* because they too fail to teach or suggest the presently claimed friction modifying compound.

Accordingly, the combination of *Norman*, *Cook*, and *STN Structure* fails to teach or suggest all of the claimed elements. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection.

4. U.S. Patent No. 4,710,100 in view of *Cook*

The Examiner has rejected claims 21-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,710,100 to Laing et al. (hereinafter "*Laing*") in view of *Cook*. Applicants respectfully submit that claims 21 and 22 depend from independent claim 8 and are patentable for the same reasons as claim 8. Claim 8 has not been rejected over *Laing* in view of *Cook*.

The Examiner has argued that the difference between *Laing* and the present invention is the requirement in the present claims of specific composition. *Cook* does not overcome the deficiency of *Laing* because, as argued above, *Cook* fails to teach or suggest the presently claimed specific composition, i.e., friction modifying compound (c).

For at least this reason, the combination of *Laing* and *Cook* does not teach or suggest all of the claimed elements. Applicants respectfully request reconsideration and withdrawal of the rejection.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 50-2961.

Respectfully submitted,

Dated: November 16, 2007

By: Carol L. Cole  
Carol L. Cole  
Reg. No. 43, 555